

### **Remarks**

In view of the above amendments and the following remarks, reconsideration of the rejection and further examination are requested.

Initially, it is noted that claims 1-3, 5-7, 9-18, 20, 24, 28, 32, 36, 39, 43, 47, 50, 54 and 58 have been amended to clarify the claimed invention, as recited therein.

Claims 1-20, 24, 28, 32, 36, 39, 43, 47, 48, 50, 54 and 58 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of Hanna (US 7,054,905), Pollack (US 6,505,236) and Prahlad (US 2007/0143431).

The above-mentioned rejection is respectfully traversed and submitted to be inapplicable to the claims for the following reasons.

Independent claim 1 recites the features of an e-mail transmission/reception system including a mail terminal, a mail server, and a mail gateway. The mail gateway is connected to the mail terminal via a network and to the mail server via another network.

The mail server includes: an attached file holding unit operable to receive a single e-mail addressed to a user of the mail terminal, the single e-mail including a plurality of attached files, and to hold the plurality of attached files included in the single e-mail; and a mail management unit operable to generate a list of the plurality of attached files included in the single e-mail.

The mail gateway includes: an attached file acquisition unit operable to receive from the mail terminal a request for transmitting unique identifiers to the mail terminal, each of the unique identifiers identifying a respective one of the plurality of attached files included in the single e-mail, and to receive from the mail server the list of the plurality of attached files included in the single e-mail, in response to the request; an identifier generation unit operable to generate the unique identifiers identifying each of the plurality of attached files, based on the received list of the plurality of attached files included in the single e-mail; a list transmission unit operable to generate an identifier list of the unique identifiers generated by the identifier generation unit and to transmit the identifier list to the mail terminal; a reception unit operable to receive a forwarding e-mail from the mail terminal, the forwarding e-mail being forwarded from the mail terminal to another mail terminal, the forwarding e-mail including at least one of the unique identifiers, the at least one unique identifier being selected at the mail terminal, at least one of the plurality of attached files included in the single e-mail corresponding

to the at least one unique identifier; and a mail transmission and reception unit operable to transmit to the mail server a request for transmitting to the mail gateway the at least one attached file included in the single e-mail corresponding to the at least one unique identifier and to receive from the mail server the at least one attached file included in the single e-mail.

The mail terminal includes: a list reception unit operable to receive the identifier list from the mail gateway; a selection receiving unit operable to display the unique identifiers included in the received identifier list in a selectable manner; a preparation unit operable to prepare the forwarding e-mail, the forwarding e-mail including the at least one unique identifier selected by the user of the mail terminal as a substitute for the at least one attached file included in the single e-mail corresponding to the at least one unique identifier; and a transmission unit operable to transmit the prepared forwarding e-mail to the mail gateway.

Additionally, the attached file acquisition unit is operable to receive from the mail server the at least one attached file included in the single e-mail based on the at least one unique identifier included in the forwarding e-mail; the mail gateway further includes a construction unit operable to construct a file attached forwarding e-mail by attaching the at least one attached file received from the mail server to the forwarding e-mail received from the mail terminal; and the mail server further includes a mail distribution unit operable to receive the file attached forwarding e-mail transmitted from the mail gateway and to distribute the file attached forwarding e-mail to the another mail terminal.

Independent claim 5 recites a related system, independent claims 9 and 13 recite related mail gateways, independent claim 17 recites a related mail terminal, independent claims 20, 24, 28, 32, and 36 recite related methods, independent claims 39, 43, and 47 recite related recording mediums, and independent claims 50, 54, and 58 recite related programs.

It is submitted that the combination of AAPA, Hanna, Pollack and Prahlad does not disclose or suggest the above-noted combination of features recited in the pending claims.

Regarding AAPA, it discloses a system in which a mail terminal does not receive an attached file, per se, and transfers an e-mail including the attached file to an address. However, AAPA provides no disclosure or suggestion of a situation where multiple files have been attached to one e-mail. Further, AAPA provides no disclosure or suggestion of a situation where one identifier is associated with each of a plurality of files attached to a single e-mail.

In setting forth the rejection, the Examiner asserts that "[a]ccording to the claim language, it does not limit the environment where there are multiple files being attached to one e-mails [sic]. Therefore, the prior art still reads on the limitations." By the present amendment, the pending claims have been amended to clarify the scope of the present invention, inserting, for example, a mail server that is "operable to receive a single e-mail addressed to a user of said mail terminal, the single e-mail including a plurality of attached files, and to hold the plurality of attached files included in the single e-mail" into, for example, claim 1.

Claim 1 further recites a mail gateway which receives a forwarding e-mail from the mail terminal, the forwarding e-mail being forwarded from the mail terminal to another mail terminal, the forwarding e-mail including at least one of the unique identifiers, the at least one unique identifier being selected at the mail terminal, the at least one attached file included in the single e-mail corresponding to the at least one unique identifier, which receives from the mail server the at least one attached file included in the single e-mail, and which constructs a file attached forwarding e-mail by attaching the at least one attached file received from the mail server to the forwarding e-mail received from the mail terminal.

However, as discussed in the remarks filed on October 7, 2005, according to AAPA, when a plurality of attached files are includes in a single e-mail, there is a problem in that a file to be attached cannot be selected from the plurality of attached files because all files included in the single e-mail are attached to the e-mail and because one mail ID is used for linking an e-mail identified by the one mail ID with the files attached to the e-mail identified by the one mail ID.

On the other hand, according to the present invention, when a plurality of attached files are includes in a single e-mail, a file to be attached can be selected from the plurality of attached files.

The Examiner also asserts that "[I]mitations such as 'a construction unit operable to construct a file attached e-mail by attaching the at least one attached file acquired by said attached file acquisition unit to the attached-file specifying e-mail received by said reception unit' is [sic] still able to read on by [sic] the cited art of records [sic] AAPA ..., where the gateway must construct a file attached e-mail in order for user to retrieve the mail attachments." However, by the present amendment, the claims have been amended to clarify the scope of the present invention. For example, amended claim 1 recites a mail terminal which prepares the forwarding e-mail, the forwarding e-mail including the at least one unique identifier selected by

the user of the mail terminal as a substitute for the at least one attached file included in the single e-mail corresponding to the at least one unique identifier, and transmits the prepared forwarding e-mail to the mail gateway. Amended claim 1 also recites a mail gateway which receives from the mail server the at least one attached file included in the single e-mail based on the at least one unique identifier included in the forwarding e-mail, and constructs a file attached forwarding e-mail by attaching the at least one attached file received from the mail server to the forwarding e-mail received from the mail terminal. It is submitted that these limitations clearly do not read on AAPA, because AAPA merely teaches that all files included in the single e-mail are attached to the e-mail and that one mail ID is used to link an e-mail identified by the one mail ID with all files attached to the e-mail identified by the one mail ID. Thus, AAPA fails to disclose or suggest a forwarding e-mail that includes the at least one unique identifier selected by the user of the mail terminal as a substitute for the at least one attached file included in the single e-mail corresponding to the at least one unique identifier.

Therefore, it is submitted that the pending claims recite features that are clearly not disclosed or suggested by AAPA. As a result, at least one of Hanna, Pollack and Prahlad must disclose or suggest each of these features in order for the combination of references to render the claims obvious.

Regarding Hanna, it is relied upon in the rejection as disclosing a number of features that are lacking from AAPA. Hanna relates to a system in which a file attached to an e-mail message is replaced with the file's location (i.e., a URL). (See Figure 2). In Hanna, an e-mail server stores an e-mail message, a file server stores files attached to the e-mail message, and the e-mail server is different from the file server. Therefore, Hanna can prevent the mail server from be filled with files attached to the e-mail message. (See column 1, lines 50-67).

However, Hanna fails to disclose or suggest at least a mail gateway which receives a forwarding e-mail from the mail terminal, the forwarding e-mail being forwarded from the mail terminal to another mail terminal, the forwarding e-mail including at least one unique identifier, the at least one unique identifier being selected at the mail terminal, the at least one attached file included in the single e-mail being corresponded to the at least one unique identifier, which receives from the mail server the at least one attached file included in the single e-mail, and which constructs a file attached forwarding e-mail by attaching the at least

one attached file received from the mail server to the forwarding e-mail received from the mail terminal.

Rather, Hanna discloses a mail server which constructs an e-mail including a plurality of URLs corresponding to all of files attached to the e-mail message, and discloses that a recipient who receives an e-mail including the plurality of the URLs from the mail server accesses the file server using URLs included in the received e-mail in order to retrieve files attached to the e-mail from the file server.

In other words, Hanna does not contain any disclosure or suggestion of a mail gateway which constructs a file attached forwarding e-mail by attaching the at least one attached file received from the mail server to the forwarding e-mail received from the mail terminal, the at least one attached file included in the single e-mail being received from the mail server, the at least one attached file included in the single e-mail corresponding to the at least one unique identifier, the at least one unique identifier being selected at the mail terminal.

Therefore, Hanna also fails to disclose or suggest the features of claim 1 discussed above that are lacking from AAPA. As a result, at least one of Pollack and Prahlad must disclose or suggest these features.

Regarding Pollack, it discloses a system in which an attached file is stripped from an e-mail and a handler corresponding to the attached file is instead attached. A URL is disclosed as a specific example of the handler. (See column 5, lines 17-22 and Figure 1). Thus, the system of Pollack is similar to that of Hanna, and also fails to disclose or suggest the above-discussed features of claim 1.

Therefore, Pollack also fails to disclose or suggest the features of claim 1 disclosed above that are lacking from AAPA. As a result, Prahlad must disclose or suggest these features.

Regarding Prahlad, it discloses an e-mail management system 100 which includes an e-mail browser 108 having a time variance interface 110. The e-mail browser 108 provides for retrieval, from a storage media 104, of the e-mail messages corresponding to a date specified by a user. The e-mail message is retrieved without attachments unless the attachment is specifically requested by the user. (See paragraph [0024])

However, it is clear that Prahlad also fails to disclose or suggest at least a mail gateway which receives a forwarding e-mail from the mail terminal, the forwarding e-mail being forwarded from the mail terminal to another mail terminal, the forwarding e-mail including at least one unique identifier, the at least one unique identifier being selected at the mail terminal, the at least one attached file included in the single e-mail corresponding to the at least one unique identifier, which receives from the mail server the at least one attached file included in the single e-mail, and which constructs a file attached forwarding e-mail by attaching the at least one attached file received from the mail server to the forwarding e-mail received from the mail terminal. Rather, Prahlad merely teaches that the e-mail message are retrieved without attachments unless the attachments is specifically requested by the user, and thus, the e-mail browser operates in a quick and efficient manner to generate the message list that corresponds to the date specified by the user.

Therefore, it is apparent that Prahlad also fails to address the deficiencies of AAPA.

Accordingly, it is submitted that even if one attempted to combine the disclosures of AAPA with Hanna, Pollack and Prahlad in the manner suggested by the Examiner, one would fail to arrive at the presently claimed invention, as such a combination would lack, at least, a mail gateway which receives a forwarding e-mail from the mail terminal, the forwarding e-mail being forwarded from the mail terminal to another mail terminal, the forwarding e-mail including at least one unique identifier, the at least one unique identifier being selected at the mail terminal, the at least one attached file included in the single e-mail corresponding to the at least one unique identifier, which receives from the mail server the at least one attached file included in the single e-mail, and which constructs a file attached forwarding e-mail by attaching the at least one attached file received from the mail server to the forwarding e-mail received from the mail terminal, as recited, for example, in claim 1.

As for claims 5, 9, 13, 17, 20, 24, 28, 32, 36, 39, 43, 47, 50, 54 and 58, they are patentable over the combination of AAPA, Hanna, Pollack and Prahlad for including at least one feature similar to one of the features discussed above with regard to claim 1, which is not disclosed or suggested by the combination.

Therefore, Applicants submit that the suggested combination of AAPA with Hanna, Pollack and Prahlad does not render the presently claimed invention obvious, and thus, respectfully request that the U.S.C. § 103(a) rejection be withdrawn.

Because of the above-mentioned distinctions, it is believed clear that claims 1-20, 24, 28, 32, 36, 39, 43, 47, 48, 50, 54 and 58 are allowable over the references relied upon in the rejection. Furthermore, it is submitted that the distinctions are such that a person having ordinary skill in the art at the time of invention would not have been motivated to make any combination of the references of record in such a manner as to result in, or otherwise render obvious, the present invention as recited in claims 1-20, 24, 28, 32, 36, 39, 43, 47, 48, 50, 54 and 58. Therefore, it is submitted that claims 1-20, 24, 28, 32, 36, 39, 43, 47, 48, 50, 54 and 58 are clearly allowable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that there are issues remaining which must be resolved before allowance of the application.

Respectfully submitted,

Susumu KOBAYASHI et al.

By: /David M. Ovedovitz/  
2008.09.30 12:56:52 -04'00'  
David M. Ovedovitz  
Registration No. 45,336  
Attorney for Applicants

DMO/jmj  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
September 30, 2008